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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/936,828	09/18/2001	Goran Uhlin	33897	1547

116 7590 10/07/2003

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CLEVELAND, OH 44114-3108

EXAMINER
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PERRIN, JOSEPH L

ART UNIT	PAPER NUMBER
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1746

DATE MAILED: 10/07/2003

4

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/936,828

Applicant(s)

UHLIN, GORAN

Examiner

Joseph L. Perrin, Ph.D.

Art Unit

1746

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 18 September 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☒ Claim(s) 4 and 7 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 18 September 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## **DETAILED ACTION**

### ***Information Disclosure Statement***

1. It is noted that an Information Disclosure Statement under 37 CFR 1.97 for the present application has not been received by the Office. If Applicant believes this to be in error, Applicant is urged to submit documentation supporting a proper filing of any previously submitted information disclosure statements in order to have such disclosures considered by the Office.

### ***Specification***

2. A substitute specification with the claims is required pursuant to 37 CFR 1.125(a) because the specification, which appears to be a direct translation of a foreign document, is replete with language not in idiomatic English and with misspellings. For instance, on page 1, line 13 (the term "preferebly") and line 28 (the term "chemicaly") are misspelled.

3. A substitute specification filed under 37 CFR 1.125(a) must only contain subject matter from the original specification and any previously entered amendment under 37 CFR 1.121. If the substitute specification contains additional subject matter not of record, the substitute specification must be filed under 37 CFR 1.125(b) and (c).

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

### **Arrangement of the Specification**

Art Unit: 1746

4. As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or  
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.
  - (1) Field of the Invention.
  - (2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.
- (f) BRIEF SUMMARY OF THE INVENTION.
- (g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).
- (h) DETAILED DESCRIPTION OF THE INVENTION.
- (i) CLAIM OR CLAIMS (commencing on a separate sheet).
- (j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).
- (k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A "Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

#### Content of Specification

- (a) Title of the Invention: See 37 CFR 1.72(a) and MPEP § 606. The title of the invention should be placed at the top of the first page of the specification unless the title is provided in an application data sheet. The title of the invention should be brief but technically accurate and descriptive, preferably from two to seven words may not contain more than 500 characters.
- (b) Cross-References to Related Applications: See 37 CFR 1.78 and MPEP § 201.11.

Art Unit: 1746

- (c) Statement Regarding Federally Sponsored Research and Development:  
See MPEP § 310.
- (d) Incorporation-By-Reference Of Material Submitted On a Compact Disc:  
The specification is required to include an incorporation-by-reference of electronic documents that are to become part of the permanent United States Patent and Trademark Office records in the file of a patent application. See 37 CFR 1.52(e) and MPEP § 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text were permitted as electronic documents on compact discs beginning on September 8, 2000.  
  
Or alternatively, Reference to a "Microfiche Appendix": See MPEP § 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.
- (e) Background of the Invention: See MPEP § 608.01(c). The specification should set forth the Background of the Invention in two parts:
  - (1) Field of the Invention: A statement of the field of art to which the invention pertains. This statement may include a paraphrasing of the applicable U.S. patent classification definitions of the subject matter of the claimed invention. This item may also be titled "Technical Field."
  - (2) Description of the Related Art including information disclosed under 37 CFR 1.97 and 37 CFR 1.98: A description of the related art known to the applicant and including, if applicable, references to specific related art and problems involved in the prior art which are solved by the applicant's invention. This item may also be titled "Background Art."
- (f) Brief Summary of the Invention: See MPEP § 608.01(d). A brief summary or general statement of the invention as set forth in 37 CFR 1.73. The summary is separate and distinct from the abstract and is directed toward the invention rather than the disclosure as a whole. The summary may point out the advantages of the invention or how it solves problems previously existent in the prior art (and preferably indicated in the Background of the Invention). In chemical cases it should point out in general terms the utility of the invention. If possible, the nature and gist of the invention or the inventive concept should be set forth. Objects of the invention should be treated briefly and only to the extent that they contribute to an understanding of the invention.

Art Unit: 1746

- (g) Brief Description of the Several Views of the Drawing(s): See MPEP § 608.01(f). A reference to and brief description of the drawing(s) as set forth in 37 CFR 1.74.
- (h) Detailed Description of the Invention: See MPEP § 608.01(g). A description of the preferred embodiment(s) of the invention as required in 37 CFR 1.71. The description should be as short and specific as is necessary to describe the invention adequately and accurately. Where elements or groups of elements, compounds, and processes, which are conventional and generally widely known in the field of the invention described and their exact nature or type is not necessary for an understanding and use of the invention by a person skilled in the art, they should not be described in detail. However, where particularly complicated subject matter is involved or where the elements, compounds, or processes may not be commonly or widely known in the field, the specification should refer to another patent or readily available publication which adequately describes the subject matter.
- (i) Claim or Claims: See 37 CFR 1.75 and MPEP § 608.01(m). The claim or claims must commence on separate sheet or electronic page (37 CFR 1.52(b)(3)). Where a claim sets forth a plurality of elements or steps, each element or step of the claim should be separated by a line indentation. There may be plural indentations to further segregate subcombinations or related steps. See 37 CFR 1.75 and MPEP § 608.01(i)-(p).
- (j) Abstract of the Disclosure: See MPEP § 608.01(f). A brief narrative of the disclosure as a whole in a single paragraph of 150 words or less commencing on a separate sheet following the claims. In an international application which has entered the national stage (37 CFR 1.491(b)), the applicant need not submit an abstract commencing on a separate sheet if an abstract was published with the international application under PCT Article 21. The abstract that appears on the cover page of the pamphlet published by the International Bureau (IB) of the World Intellectual Property Organization (WIPO) is the abstract that will be used by the USPTO. See MPEP § 1893.03(e).
- (k) Sequence Listing. See 37 CFR 1.821-1.825 and MPEP §§ 2421-2431. The requirement for a sequence listing applies to all sequences disclosed in a given application, whether the sequences are claimed or not. See MPEP § 2421.02.

***Claim Objections***

5. Claim 4 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Specifically, claim 4 is directed to a usable fluid, e.g. carbon dioxide, which is considered a future intended use, and thus fails to provide any further structural limitation to the claimed apparatus.

6. Claim 4 is objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim cannot depend from any other multiple dependent claim. See MPEP § 608.01(n). Accordingly, the claim 4 has not been further treated on the merits.

7. Claim 7 is objected to because of the following informalities: The claimed "container (80)" should be a vaporizer box, as disclosed in the specification (page 8, line 25 of the specification). Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

8. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

9. Claims 5-7 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a textile cleaning apparatus with either an evaporator (36) separate from the treatment chamber (for instance, in Figure 1) or an

Art Unit: 1746

evaporator (80) as part of the treatment chamber (for instance, in Figure 2), does not reasonably provide enablement for a textile cleaning apparatus with both types of evaporators. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims.

10. Specifically, the original disclosure as filed, while being enabling for either arrangement in separate embodiments in the alternative only, is not enabling for an apparatus including both evaporators (see, the original description on page 8, lines 28-30, which states the embodiment of Figure 2 having an evaporator "directly from the treatment chamber 10 instead of from a separate evaporator 36 [as in Figure 2]" (emphasis added)).

11. Moreover, claim 7, while being enabling for a heat exchanger (82), does not reasonably provide enablement for a "tube (82)". The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make/use the invention commensurate in scope with these claims. The original disclosure as filed, while being enabling for a heat exchanger or condenser, is not enabling for the broader term of a tube.

12. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.



Art Unit: 1746

13. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, line 7, the phrase "compressor means (46) arranged, ..." is considered vague and indefinite. It is unclear what applicant intends. How exactly is reference numeral (46) arranged? If the claims language is a result of a direct translation from a foreign document, as is believed to be the case, applicant is urged to amend the claims language in proper idiomatic English to more particularly point out and distinctly claim the subject matter of applicant's invention.

Regarding claims 1, 6 and 7, the word "means" is preceded by the word(s) "compressor" and "condenser" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function is specified by the word(s) preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

In claims 1-7, the phrase "characterized therein" renders the claim as vague and indefinite. It is unclear what applicant intends. The transitional word (*i.e.* language between the preamble and at least part of the body of the claim) "characterized therein" and phrases incorporating it are common in applications of European origin. In U.S. practice, claims containing those words and phrases are rejectable under 35 USC 112, second paragraph, when characterization may connote more than mere description (dictionary definition); in scientific parlance, characterization may imply one or more

Art Unit: 1746

physical steps or procedures (e.g. structure determination, elemental analysis, or qualitative tests) to identify a product. Since it is rare that applicant intends more than a mere description when using this language, physical steps are rarely disclosed. As such the reader may be unsure about the meaning of the wording of the claims, and additionally the scope of the claim is often unclear ("characterized" conveys no degree of openness). Usually these troublesome words or phrases can be replaced by the standard transitional words, "having", "comprising", "wherein" and the like.

In claim 6, the "the condensor means (80,82)" renders the claim as vague and indefinite. Is applicant referring to the condenser claimed in claim 1 or a separate condenser such as heat exchanger (82)? The claims language is further confusing since reference numeral (80) is defined as a vaporizer box in the specification.

Clarification and correction are required.

### ***Claim Rejections - 35 USC § 102***

14. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

15. Claims 1-3 are rejected under 35 U.S.C. 102(e) as being anticipated by US 5,904,737 to Preston *et al.* (hereinafter "Preston").

Re claim 1, Preston discloses a textile cleaning apparatus including a treatment chamber 32/132, supply tank 20/120, evaporator chamber 70/170, compressor 14/114, multiple lines/tubes thereby connecting each other, and a "condenser means" (tank 18/118) in "heat transmitting contact" with evaporator 70 (see entire reference of Preston, for instance, col. 4, lines 2-38; col. 5, line 61 – col. 6, line 50; and Figures 1A-M & 2).

Re claim 2, Preston further discloses an additional heat exchanger (tank 12/112) which cools/condenses the fluid prior to transfer to supply tank 20/120 (see entire reference of Preston, for instance, col. 6, lines 13-15).

Re claim 3, Preston further teaches that it is known to arrange the apparatus such that the "liquid carbon dioxide is gravity fed" (see, for instance, col. 1, lines 33-36).

16. Claims 1-3 and 5-6 are rejected under 35 U.S.C. 102(e) as being anticipated by US 5,946,945 to Kegler *et al.* (hereinafter "Kegler").

Re claim 1, Kegler discloses a textile cleaning apparatus including a treatment chamber (cleaning vessel 11), a supply/storage tank 15, an evaporator chamber 12 with condensing means, a compressor 14, and multiple lines/tubes thereby connecting each other (see entire reference of Kegler, for instance, Figure 1 and col. 3, line 13 – col. 4, line 22).

Re claim 2, Kegler further discloses an additional heat exchanger (condenser, not shown) "where [carbon dioxide] is reliquified and then returned to the storage tank 15" (see, for instance, col. 4, lines 7-12).

Re claim 3, Kegler further discloses a gravity fed arrangement (see, for instance, Figure 1).

Re claims 5-6, Kegler further discloses the treatment chamber with a condenser/heat exchanger 21 "to aid in temperature and pressure control of the carbon dioxide in the cleaning vessel 11" (see, for instance, col. 3, lines 52-57).

### ***Allowable Subject Matter***

17. Claim 7 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, first and second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

18. The prior art of record does not teach or suggest the claimed invention further including a second heat exchanger at the bottom of a treatment chamber.

19. However, it is noted that this limitation is rejected as not enabling (see 112, first paragraph, rejection above) and therefore, may be subject to a new matter rejection upon amendment to the specification and/or drawings.

### ***Conclusion***

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

US 5,827,329 to Champeau, which discloses a textile cleaning apparatus with heat exchangers to heat/cool carbon dioxide, and a storage tank.

US 5,412,958 to Iliff *et al.*, which discloses a textile cleaning apparatus with treatment chamber having heating coils in bottom of chamber to heat/cool CO<sub>2</sub>.

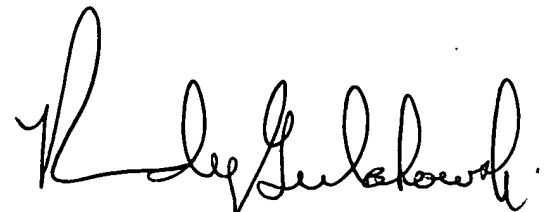
21. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph L. Perrin, Ph.D. whose telephone number is (703)305-0626. The examiner can normally be reached on M-F 7:30-5:00, except alternate Fridays.

22. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Randy P. Gulakowski can be reached on (703)308-4333. The fax phone numbers for the organization where this application or proceeding is assigned are (703)872-9310 for regular communications and (703)872-9311 for After Final communications.

23. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0661.

Joseph L. Perrin, Ph.D.  
Examiner  
Art Unit 1746

jlp



RANDY GULAKOWSKI  
SUPERVISORY PATENT EXAMINER  
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